REMARKS

1. Summary of the office action

In the office action mailed September 17, 2008, (i) the Examiner rejected claims 1, 7-10, 12, 13, 20, 21, 23, 24, 26-28, 31, 33, and 34 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2001/0049820 (Barton) in view of U.S. Patent No. 7,039,933 (Chen)[1], (ii) the Examiner rejected claims 29 and 30 under 35 U.S.C. § 103(a) as being unpatentable over Barton in view of Chen and U.S. Patent No. 5,272,525 (Borchardt), (iii) the Examiner rejected claim 32 under 35 U.S.C. § 103(a) as being unpatentable over Barton in view of Chen and U.S. Patent Application Publication No. 2003/0195797 (Klug), (iv) the Examiner rejected claims 1, 7-10, 12, 13, 20, 21, 23, 24, 26-28, 31, 33, and 34 under 35 U.S.C. § 103(a) as being unpatentable over Barton in view of Official Notice[2], (v) the Examiner rejected claims 29 and 30 under 35 U.S.C. § 103(a) as being unpatentable over Barton in view of the Official Notice and further in view of Borchardt, and (vi) the Examiner rejected claim 32 under 35 U.S.C. § 103(a) as being unpatentable over Barton in view of the Official Notice and further in view of Klug.

[1] At item 2 on page 2 of the office action the Examiner indicated that claims 1-3, 7-15, and 18-26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Barton in view of Chen. This appears to be an error since claims 2, 3, 11, 14, 15, 18, 19, 22, and 25 were cancelled at the time the office action was mailed.

[2] At item 13 on page 6 of the office action the Examiner indicated that claims 1-3, 7-15, and 18-26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Barton in view of Official Notice. This appears to be an error since claims 2, 3, 11, 14, 15, 18, 19, 22, and 25 were cancelled at the time the office action was mailed.

2. Amendments and pending claims

Applicant has amended claims 1, 8-10, 20, 21, 27-31, 33, and 34. Now pending in this application are claims 1, 7-10, 12, 13, 20, 21, 23, 24, and 26-34. Of the pending claims, claims 1 and 20 are independent.

3. Response to claim rejections

a. Barton and Chen

The Examiner rejected independent claims 1 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Barton in view of Chen. Applicant submits that the Examiner has not established *prima facie* obviousness of claims 1 and 20 based on Barton and Chen.

According to M.P.E.P. § 2142, the key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. § 103 should be made explicit. Furthermore, rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. (See, *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

In rejecting independent claims 1 and 20, the Examiner argued that Barton teaches, *inter alia*, a bookending function which can insert and play advertising before a user-selected, pre-recorded program is played, and both the beginning and end of the requested program content are taken to represent detections of a mode change and trigger obtaining/determination of an appropriate advertisement. (See, office action, page 2, last

paragraph). Then the Examiner stated, "Regarding the claimed feature that the advertising is displayed along with the video of the modes, it is unstated whether or not there is any visual overlap from the 1st mode (the menu) into the ad or whether or not there is any visual overlap out of the ad into the 2nd mode (the requested program). However it is clear that Barton teaches a sequence of 1st mode (menu),...advertising...2nd mode (the requested program)." (See, office action, page 2, last paragraph).

To make up for the deficiency of Barton, the Examiner argued that Chen teaches, *inter alia*, it is well known for displayed TV programming to include enhanced effects for the inclusion of advertisements, and that advertising enhancements may be displayed in a manner such that graphical and information (advertising) may be shown on the screen at the same time as the video program. (See, office action, page 3, first paragraph). The Examiner then concluded that, given the wide variety of techniques for displaying the advertising enhancements, it would have been obvious to one of ordinary skill at the time of the invention to have shown the triggered advertising of Barton in any of such manners for various effects, each of which provide ad content on the screen at the same time as the 1st and 2nd mode. (See, office action, page 3, first paragraph). The Examiner also concluded that it would have been obvious to one of ordinary skill at the time of the invention to have overlaid (for example) the ad over the menu as the menu disappears, and for the end of the advertising to be shown as overlaid as the beginning of the requested show started. (See, office action, page 3, first paragraph).

Applicant submits that the Examiner has not articulated any reasoning with rational underpinning to support these legal conclusions of obviousness of claims 1 and 20 over Barton and Chen. In particular, the Examiner did not indicate why it would have

been obvious to a person having ordinary skill in the art to modify Barton with Chen so as to lead to the invention of claims 1 and 20. Therefore, Applicant submits that the Examiner has not established *prima facie* obviousness of claims 1 and 20 based on Barton on Chen.

Additionally, Applicant has amended independent claims 1 and 20. As amended, claims 1 and 20 now provide, *inter alia*, the DVR placing the ad into the digital video output stream so that the digital video output stream includes the video of the user interface and the ad but does not include the video of the program recorded at the DVR, wherein the DVR that places the ad into the digital video output stream outputs the digital video output stream to a display device that is connected directly to the DVR. Applicant submits that Barton and Chen do not reasonably lead to this functionality, as provided for in amended claims 1 and 20.

Barton, at best, discloses: (i) ***DVRs that take as input television broadcast signals*** from multiple signal sources, (ii) multiple programs are stored on a persistent device 103, e.g., a magnetic hard disk or RAM device and are easily accessed by a viewer, (iii) the viewer selects a desired program stored on the storage device 103 through a viewer interface 104, (iv) the selected program is accessed from the storage device 103 and decoded into analog form for presentation onto a television set by a decode module 105, and (v) an output module 106 presents the decode module's 105 output into an acceptable signal format (analog or digital) to the viewer's television or monitor. (See, e.g., Barton, paragraphs 0027 to 0029 and figure 1, emphasis added). Barton also discloses the bookending function that displays an advertisement ***before***

and/or after a program that has been recorded on the DVR's storage device is played to a viewer. (See, Barton, abstract, emphasis added).

Chen relates to an enhanced ***TV broadcasting system, method, and program*** product using tags for incorporating local content into a communication stream containing program content. (See, Chen, col. 1, lines 10-13, emphasis added). At best, Chen discloses: (i) an emerging technology called Enhanced TV (ETV) aids in inserting local program content and targeted commercials to station and cable viewers, (ii) ETV uses certain technologies from the Internet to deliver graphical and informational elements as components on the same screen as a video program, (iii) once transmitted over the air or via telephone wires or cables, the components are televised on top of video programming as enhancements and viewed on traditional TV sets, computers, and on other video-ready digital products, (iv) to the viewer, "enhancements" appear as graphical and sometimes purely informational elements on the screen and overlay a ***video broadcast***, and (v) often the enhancements are opaquely colored and cover the ***video broadcast*** in part or are transparent or semi-transparent. (See, e.g., Chen, col. 1, lines 22-37, emphasis added).

With respect to amended claims 1 and 20, as far as Applicant can tell, the combination of Barton and Chen, at best, teach that: (i) a TV broadcasting system uses tags to incorporate local content into a communication stream containing program content, (ii) a DVR takes the communication stream containing program content and the local content as input and records the communication stream containing the program content and the local content, (iii) a viewer selects the program (i.e., the program content and the local content) recorded on a storage device through a viewer interface, and (iv) an

advertisement is displayed before and/or after the program (i.e., the program content and the local content) that has been recorded on the DVR's storage device is played to a viewer. However, even if, for the sake of argument, it is assumed that the local content that is incorporated into the communication stream by the TV broadcasting system amounts to an advertisement, Barton and Chen do not reasonably disclose or suggest that the program content combined with the local content amounts to video of a user interface. Therefore, Applicant submits that Barton and Chen do not reasonably lead to a DVR placing the ad into the digital video output stream so that the digital video output stream includes the video of the user interface and the ad but does not include the video of the program recorded at the DVR, wherein the DVR that places the ad into the digital video output stream outputs the digital video output stream to a display device that is connected directly to the DVR, as provided for in amended claims 1 and 20.

For at least these reasons, Applicant submits that claims 1 and 20 are allowable over Barton and Chen. Further, because each of claims 7-10, 12, 13, 21, 23, 24, 26-28, 31, 33, and 34 depend from one of claims 1 and 20 and necessarily include all of the limitations of one of claims 1 and 20, Applicant submits that claims 7-10, 12, 13, 21, 23, 24, 26-28, 31, 33, and 34 are allowable over Barton and Chen as well.

b. Barton and Official Notice

The Examiner rejected claims 1, 20, 21, 24, 26-28, 33, and 34 under 35 U.S.C. § 103(a) as being unpatentable over Barton in view of Official Notice. On page 6 of the office action, the Examiner took Official Notice that it is well known to enhance video content by including visual transitions between portions of video content. On page 7 of the office action, the Examiner took Official Notice that advertising has typically been

accomplished with a "crawl," a scrolling ticker, a transparent banner, or overlaid still text all of which are taken to provide a "mini ad" and each of which would have been obvious. For purposes of this paper, the Official Notice taken on page 6 is referred to as "the first official notice," and the Official Notice taken on page 7 is referred to as "the second official notice." Applicant respectfully submits that the Examiner did not properly take official notice for this rejection of claims 1, 20, 21, 24, 26-28, 33, and 34.

First, in taking the first official notice and the second official notice, the Examiner did not indicate that the alleged facts are facts that were well known at the time of Applicant's invention. As far as Applicant can tell, the Examiner has used hindsight analysis to apply the alleged facts to the disclosure of Barton in an attempt to show *prima facie* obviousness of claims 1, 20, 21, 24, 26-28, 33, and 34. Therefore, Applicant respectfully requests that the Examiner provide evidence that the alleged facts taken as the first official notice and the second official notice were well known at the time of Applicant's invention.

Second, M.P.E.P. § 2144.03 provides that any rejection based on assertions that a fact is well known or common knowledge in the art without documentary evidence to support the Examiner's conclusion should be judicially applied. M.P.E.P. § 2144.03 also provides that any facts so noticed should be of notorious character and serve only to "fill in the gaps" in an insubstantial manner which might exist in the evidentiary showing made by the Examiner to support a particular ground for rejection.

In rejecting claims 1, 20, 21, 24, 26-28, 33, and 34, the Examiner stated, "Regarding the claimed feature that the advertising is displayed along with the video of the modes, it is unstated whether or not there is any visual overlap from the 1st mode (the

menu) into the ad or whether or not there is any visual overlap out of the ad into the 2nd mode (the requested program)." (See, office action, page 6). As far as Applicant can tell, in rejecting claims 1 and 20, the Examiner used the first official notice to fill in these gaps of Barton. Applicant submits that the Examiner's use of the first official notice to reject claims 1 and 20 consists of more than filling in the gaps in an insubstantial manner. Indeed, the Examiner used the first official notice to fill in the gaps of a single reference that does not teach or suggest all of the elements of claims 1 and 20. For these additional reasons, Applicant submits that the Examiner did not properly take official notice in rejecting independent claims 1 and 20.

Finally, even if, for the sake of argument, it is assumed that the Examiner properly took official notice in rejecting claims 1, 20, 21, 24, 26-28, 33, and 34, Applicant submits that Barton, the first official notice, and the second official notice do not reasonably lead to all of the limitations recited in amended claims 1 and 20. At a minimum, Barton, the first official notice and the second official notice do not reasonably lead to the DVR placing the ad into the digital video output stream so that the digital video output stream includes the video of the user interface and the ad but does not include the video of the program recorded at the DVR, wherein the DVR that places the ad into the digital video output stream outputs the digital video output stream to a display device that is connected directly to the DVR.

For at least these reasons, Applicant submits that claims 1 and 20 are allowable over Barton, the first official notice, and the second official notice. Further, because each of claims 7-10, 12, 13, 21, 23, 24, 26-28, 31, 33, and 34 depend from one of claims 1 and 20 and necessarily include all of the limitations of one of claims 1 and 20, Applicant

submits that claims 7-10, 12, 13, 21, 23, 24, 26-28, 31, 33, and 34 are allowable over Barton, the first official notice, and the second official notice as well.

5. Conclusion

Applicant believes that all of the pending claims have been addressed in this response. However, failure to address a specific rejection or assertion made by the Examiner does not signify that Applicant agrees with or concedes that rejection or assertion.

For the foregoing reasons, Applicant submits that claims 1, 7-10, 12, 13, 20, 21, 23, 24, and 26-34 are in condition for allowance. Therefore, Applicant respectfully requests favorable reconsideration and allowance of all of the claims.

Respectfully submitted,

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